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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/877,621 | 06/08/2001 | Thomas Gassner | tesa AG 1500 | 5316 |

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| EXAMINER |
|---|
| ZIRKER, DANIEL R |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1771 | 5 |

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | Examiner | Group Art Unit | |

*—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—*

**P ri d for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☑ Claim(s) 1 - 12 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1 - 12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☑ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☑ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

**Attachment(s)**

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

**Office Acti n Summary**

1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, the claims as they presently exist contain a significant number of informalities such as in claim 1 referring to nonexisting elements in the Figures, e.g. "F1" and "PZ", and perhaps others. Additionally, in claims 9-11 multiple ranges of elements are cited in the clearly informal "especially" clauses or the "in particular" clauses.

3. Claims 1-12 are directed to the same invention as that of claims 2-10, 13 and 14 in each of two separately copending applications of commonly assigned Serial Nos. 09/490,709 or 09/518,463. Claim 9 of the pending application is rejected in each instance over the independent claim 13 in both of the prior applications since it only cites the most broad range of lengths and widths which are clearly believed to be obvious parameters. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

5. Claims 1-12 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 2-10, 13 and 14 of either copending Application No. 09/490,709 or 09/518,463. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claims 1-12 are provisionally rejected under 35 U.S.C. § 102(e) as being anticipated by copending Application No. 09/490,709 or 09/518,463, each of which has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the copending applications, it would constitute prior art under 35 U.S.C. § 102(e), if patented. This provisional rejection under 35 U.S.C. § 102(e) is based upon a presumption of future patenting of the copending applications. More particularly, although the nomenclature in each of the three applications is different in fact, as is clearly evident e.g. in the drawings, the scope of the subject matter of the claims of each application clearly read upon each of the other application's claims. Also, note that claim 9 of the pending application, while not being expressly rejected by the claims of either of the two earlier copending applications reads on such simple subject matter as the length and widths of the adhesive tape as to clearly be considered as taught by the other applications.

This provisional rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also substantially all of the relevant ~~or relied upon~~ prior art either relied upon in the closely related U.S. patent applications or referred to in applicants' specification has been made of record.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc
August 19, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~ 1700

Daniel Zirker